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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,986	01/20/2004	Oliver Klein	03/006 MFE	3486
38263	7590	12/17/2004	EXAMINER	
PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			CHEN, VIVIAN	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5K

# Office Action Summary

Application No.

10/760,986

Applicant(s)

KLEIN ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-2004, 5-2004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because it is unclear which layer(s) contain(s) polyester.

Claims 10-11 are vague and definite because it is unclear what type of molecular weight is being specified (e.g., weight average? number average?)

Claim 19 contains a typographical error in the phrase "claimed claim".

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,709,735 (POSEY ET AL) in view of COCHRAN ET AL (US 5,021,515) and ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

The above patent claims a coated polyester film comprising a polyester layer and the recited barrier layer comprising polyvinyl alcohol and a copolymer of maleic acid and acrylic acid, and method of making said film. However, the patent does not explicitly disclose the recited poly(m-xylenedipamide) (MXD6) containing layer and additional layer(s).

COCHRAN ET AL discloses a blend of polyester (e.g., polyethylene terephthalate, etc.) and 1-7 wt% MXD6 useful for forming oxygen-scavenging packaging articles and films. The reference also discloses that it is well known in the art to combine the blend layer with other polymer layers on both sides of the blend layer in order to reduce material costs. (lines 53-58, col. 4; line 43-58, col. 5; line 28-55, col. 8; line 12-32, col. 10; line 30-39, 56-60, col. 11; line 8-30, col. 12)

ULLMANN'S discloses that it is well known in the art to use in-line coating to apply functional coatings to oriented films (section 2.4.2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use known oxygen-scavenging polyester compositions in the base layer of the films claimed in U.S. Patent No. 6,709,735 to minimize the oxygen permeability of the film (claim 15). It also would have been obvious to incorporate additional layers containing the same polyester resin as contained in the oxygen-scavenging composition on one or more sides of the oxygen-scavenging layer (claims 1, 12-13) in order to protect the more environmentally sensitive

oxygen-scavenging layer, obtain good interlayer adhesion, and/or to reduce the amount of more expensive scavenging composition required to obtain the desired mechanical properties for a given application, while still obtaining good interlayer adhesion and compatibility. One of ordinary skill in the art would have selected the melt viscosity of the MXD6 (claim 4) to optimize melt processing characteristics and compatibility with the host polyester resin for specific film formulations. It also would have been obvious to select the molecular weight of the resins in the barrier layer (claims 10-11) depending on the specific physical and mechanical properties desired for specific applications. It would have been obvious to adjust the surface and optical properties (e.g., gloss, haze) (claim 14, 16) of the base layer and film depending on the requirements of a specific usage. One of ordinary skill in the art would have used conventional adhesion-promoting treatments to maximize the adhesion of the barrier coating to the base layer (claim 17).

5. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/760,987 (US 2004/0146727), in view of COCHRAN ET AL (US 5,021,515).

The copending Application claims a coated polyester film comprising the recited base layer containing poly(m-xylenedipamide) (MXD6) and polyester, and the recited barrier layer comprising polyvinyl alcohol and a copolymer of maleic acid and acrylic acid, and method of making said film. However, the reference does not explicitly disclose the additional overlayer.

COCHRAN ET AL discloses a blend of polyester (e.g., polyethylene terephthalate, etc.) and 1-7 wt% MXD6 useful for forming oxygen-scavenging packaging articles and films. The

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reference also discloses that it is well known in the art to combine the blend layer with other polymer layers on both sides of the blend layer in order to reduce material costs. (lines 53-58, col. 4; line 43-58, col. 5; line 28-55, col. 8; line 12-32, col. 10; line 30-39, 56-60, col. 11; line 8-30, col. 12)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate additional layers containing the same polyester resin as contained in the oxygen-scavenging composition on one or more sides of the oxygen-scavenging layer in order to protect the more environmentally sensitive oxygen-scavenging layer, obtain good interlayer adhesion, and/or to reduce the amount of more expensive scavenging composition required to obtain the desired mechanical properties for a given application, while still obtaining good interlayer adhesion and compatibility

This is a provisional obviousness-type double patenting rejection.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 13, 2004



Vivian Chen  
Primary Examiner  
Art Unit 1773